Docket No.: 01-8001

REMARKS

I.   Introductory Comments

Claims 27-52 are pending in the application. In the Office Action: (1) claims 27, 35-37, 45-48, 51, and 52 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,581,105 to Miloslavsky et al. (hereinafter "Miloslavsky"); and claims 28-34, 38-44, 49, and 50 were rejected under 35 U.S.C. §103(a) as being obvious over Miloslavsky in view of U.S. Patent No. 6,321,267 to Donaldson (hereinafter "Donaldson"). The Examiner found Applicants' arguments presented in the Amendment dated September 30, 2004 to be unpersuasive and made the rejections of claims 27-52 final (Final Office Action, page 1). Applicants respectfully disagree with the Examiner's interpretations of the prior art references as stated in the Final Office Action, and respectfully request reconsideration of the presently pending claims for the reasons provided below.

II.   Rejection of Claims 27, 35-37, 45-48, 51, and 52 under 35 U.S.C. §102(e)

On page 4 of the Final Office Action, the Examiner rejected claims 27, 35-37, 45-48, 51, and 52 under 35 U.S.C. §102(e) as being anticipated by Miloslavsky. Claims 27, 37, 46, and 51 are independent claims. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. For the reasons discussed below, Miloslavsky fails to meet this requirement because each and every claim element recited in claims 27, 35-37, 45-48, 51, and 52 is not disclosed in Miloslavsky, and Applicants respectfully traverse the rejections of these claims.

A.   Independent Claims 27, 37, 46, and 51

Independent claim 27 recites in part the steps of:

> ...retrieving a complaint from a complainant about an incident over the computer network;
> parsing the complaint into a plurality of components, wherein the step of parsing includes breaking up an electronic mail message nested in the complaint into the plurality of components;.... (Emphasis added.)

Similarly, independent claims 37 and 51 recite the claim limitation of breaking up an electronic mail message nested in the complaint. Independent claim 46 recites a similar claim limitation of a message parser being adapted to break a message nested in the complaint into a plurality of message components.

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On page 4 of the Final Office Action, the Examiner equates an email message disclosed in Miloslavsky with the claim limitation of a complaint as recited in claims 27 and 37. The Examiner then inconsistently equates the same email message of Miloslavsky with the electronic mail message nested in the complaint, as claimed (Final Office Action, page 4). This duplicative and inconsistent interpretation of a single email message, as disclosed in Miloslavsky, cannot reasonably be used to reject both claim limitations of retrieving a complaint and breaking up an electronic mail message nested in the complaint because a single email message is not in any way a disclosure of both a complaint and an email message nested in the complaint.

Because Miloslavsky discloses no more than a single, flat-level email message, the Examiner's interpretation of Miloslavsky is clearly incorrect. Miloslavsky discloses a call center that receives an email message from a customer. The email message is parsed at the call center to extract keywords. The keywords are then matched with predefined keywords that are associated with particular skill sets of customer service agents. Through this process, the email message can be routed to a particular customer service agent having skills helpful for responding to service requirements contained in the email message. (See Abstract of Miloslavsky.)

Contrary to the assertions of the Examiner, the parsing of the email message, as disclosed in Miloslavsky, does not include any disclosure of parsing a nested electronic mail message. Miloslavsky discloses that the parsing of an email message may extract sender and recipient addresses, time stamps, and keywords (Miloslavsky, col. 37, lines 6-22). However, the parsing disclosed in Miloslavsky is performed on a flat email message rather than on a nested email message, as evidenced by independent claims 1 and 9 of Miloslavsky, which recite the parsing of "the message body of the email, as originally authored by the sender, for keywords or phrases" (Miloslavsky, col. 39, lines 38-40 and col. 40, lines 11-13). There simply is no disclosure in Miloslavsky of an email message having another email message nested therein, much less any capability to parse a nested email message. This is partly due to Miloslavsky's focus on solving an unrelated problem, namely the efficient routing of emails in a call center (Miloslavsky, col. 39, lines 38-41).

On page 2 of the Final Office Action, the Examiner cites, "The extraction algorithm in extractor 6204 is changeable because the coding in algorithm 6208 could be changed." (Miloslavsky, col. 37, lines 4-6.) Inasmuch as the Examiner may be relying upon the changeability of the parsing algorithm of Miloslavsky to somehow disclose the claim limitation of breaking up an electronic mail message nested in a complaint, the simple ability

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to change the extraction algorithm of Miloslavsky does not in any way equate to a disclosure of breaking up a nested email message. Rather, based on the teachings of Miloslavsky, Applicants understand the changeability of the extraction algorithm to indicate no more than an ability to select what relevant information will be extracted from the flat-level email message. For example, the call center may change the particular keywords that will be extracted from the body of the email. (See Miloslavsky, col. 37, lines 1-6 and col. 39, lines 38-41). Thus, the changeability of the parsing algorithm does not in any way amount to a disclosure of the claim limitation of breaking up an electronic email message nested in a complaint.

Further, the Examiner offers a second and inconsistent interpretation of Miloslavsky, which also fails to disclose the claim limitation of an electronic mail message nested in a complaint. On page 2 of the Final Office Action, the Examiner asserts that Miloslavsky discloses "a parser for parsing the content of the e-mails obtained from the e-mail server in order to extract [an] embedded complaint in [sic] a plurality of components...." (Emphasis added.) The relevant claim limitation of claims 27, 37, 46, and 51 recites an electronic mail message nested in a complaint, not a complaint nested in an email message. Therefore, the Examiner's second interpretation of Miloslavsky, even if somehow correct, would still not disclose the claim limitation of an electronic mail message nested in a complaint. Moreover, this interpretation of Miloslavsky is not only incorrect, it is also inconsistent with the Examiner's interpretation of Miloslavsky discussed above, and as presented on page 4 of the Final Office Action. Because Miloslavsky discloses no more than parsing a single-level email message, neither interpretation of Miloslavsky presented in the Final Office Action is correct.

For the foregoing reasons, Miloslavsky fails to disclose each and every limitation recited in independent claims 27, 37, 46, and 51 because the reference does not include any disclosure of the claim limitation of breaking up an electronic mail message nested in a complaint. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections of independent claims 27, 37, 46, and 51, which are in condition for allowance. Claims 28-36, 38-45, and 52 are also in condition for allowance as claims depending from independent claims 27, 37, 46, and 51.

B.   Dependent Claims Not Anticipated by Miloslavsky

As mentioned above, dependent claims 28-36, 38-45, and 52 are in condition for allowance as claims depending from independent claims 27, 37, 46, and 51. Nevertheless, these dependent claims also recite independently patentable subject matter. Merely by way

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of example, claims 35 and 45 recite patentable subject matter. Claim 35 recites:

> The method of Claim 27, wherein the extracted information comprises one of a complaint tracking code, a source IP address, a Received Line, a First Line, a URL, and a body of one of the plurality of components.

Claim 45 recites similar claim limitations.

On page 5 of the Final Office Action, the Examiner relies upon column 11, lines 17-27 and column 12, lines 15-20 of Miloslavsky to reject claims 35 and 45. However, these sections of Miloslavsky disclose the use of a URL to enable a browser to access a particular web page but do not disclose a URL that is _extracted_ information. Moreover, the parsed addresses disclosed in Miloslavsky are limited to sender and recipient email addresses (col. 37, lines 7-9). Accordingly, Applicants respectfully request that the Examiner withdraw the rejections of claims 35 and 45, which are in condition for allowance.

While Applicants argued the patentability of claims 35 and 45 in the Amendment of September 30, 2004, the Final Office Action does not contain any response to the argument. If for some reason the Examiner continues to reject claims 35 and 45, Applicants respectfully request that the Examiner address the above-presented argument so that Applicants may know how to best respond.

III.   Rejections of Claims 28-34, 38-44, 49, and 50 under 35 U.S.C. §103(a)

On page 6 of the Final Office Action, the Examiner rejected claims 28-34, 38-44, 49, and 50 under 35 U.S.C. §103(a) as being unpatentable over Miloslavsky in view of Donaldson. The Examiner admits that Miloslavsky fails to teach the step of parsing to include locating a header. The Examiner then allegedly cures this deficiency by modifying Miloslavsky with Donaldson's teaching of locating a header message in order to reject email received from unknown hosts. (See Final Office Action, page 6.) Applicants respectfully disagree.

A.   Examples of Patentable Subject Matter Not Taught or Suggested in Prior Art References

Dependent claims 28-34, 38-44, 49, and 50 are in condition for allowance as claims depending from independent claims 27, 37, 46, and 51. Nevertheless, these dependent claims also recite independently patentable subject matter. Merely by way of example, claims 30-34 and 39-44 recite subject matter that is not taught or suggested in Miloslavsky or Donaldson, taken either alone or in combination. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. _In re Royka,_

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490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. For the reasons discussed below, the Final Office Action fails to meet this requirement, which is necessary for establishing a *prima facie* case of obviousness. Therefore, the Final Office Action fails to establish a *prima facie* case of obviousness against claims 30-34 and 39-44 for the reasons discussed below.

Applicants note that the arguments presented below, concerning examples of patentable subject matter included in claims 30-34 and 39-44 and not taught or suggested in the prior art references, were also substantively presented in Applicants' Amendment of September 30, 2004. However, the Final Office Action does not contain any response to those arguments as previously presented. Therefore, if for some reason, the Examiner continues to reject claims 30-34 and 39-44, Applicants respectfully request that the Examiner address the following arguments so that Applicants may know how best to respond.

1.   Claims 30 and 39

Claims 30 and 39 each recite the claim limitation of the normalizing step including a step of removing at least one character from a header based on a header keyword. On page 7 of the Final Office Action, the Examiner relies upon column 2, lines 38-41 of Donaldson to reject these claims. The section of Donaldson relied upon by the Examiner discloses removing a message from a sending host device once a transmission of the message is complete (Donaldson, col. 2, lines 37-41). The removal of an entire message from the queue of a sending host device is entirely different from the claim limitation of normalizing by removing a character from a header. Clearly, the section of Donaldson relied upon by the Examiner does not in any way teach or disclose this claim limitation as recited in claims 30 and 39. Therefore, Applicants respectfully request that the Examiner withdraw the rejections of claims 30 and 39.

2.   Claims 31 and 40

Claims 31 and 40 recite the claim limitation of "locating a Received line." On page 7 of the Office Action, the Examiner relies upon column 2, lines 49-61 and column 3, lines 5-14 of Donaldson to reject these claims. However, these sections of Donaldson teach that protocol messages are transferred as sequences of ASCII characters that end with a specific "newline" character (col. 2, lines 49-61 and col. 3, lines 5-14). A "newline" character, as understood by those skilled in the art, is entirely unrelated to the claim limitation of a Received line. The term "Received line" has specific meaning in the field of email messaging. While Donaldson appears to disclose merely that a message header includes Received lines (col. 4, lines 24-31), Donaldson does not include any teaching or suggestion

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of locating the Received lines as recited in claims 31 and 40. Therefore, the Final Office Action fails to establish a *prima facie* case of obviousness against these claims, and Applicants respectfully request that the Examiner withdraw the rejections of claims 31 and 40. Claims 32, 33, and 41-43 are also in condition for allowance as claims depending from claims 31 and 40.

3.   Claims 32, 41, and 42

Claims 32 and 41 recite the claim limitation of validating a source IP address from the Received line. Claim 42 recites the claim limitation of using the Received line to validate an IP address of a source of the complaint. On pages 7 and 8 of the Final Office Action, the Examiner relies upon Figure 3, column 3, lines 39-41, column 4, lines 15-21, and column 4, lines 53-61 of Donaldson to reject these claims. However, these sections of Donaldson are directed to a process for connecting a sending Message Transfer Agent (MTA) to a receiving mail server for the transmission of email messages, as well as to the body of an email address containing contact information. The cited sections of Donaldson do not contain any teaching or suggestion of the claim limitation of validating a source IP address from the Received line. In contrast, Donaldson teaches the use of the body of an email to identify a solicitor's contact information because junk mail frequently does not include a recipient's address in the header of the message (col. 4, lines 50-58). Therefore, the Final Office Action does not establish a *prima facie* case of obviousness against claims 32, 41, and 42, and Applicants respectfully request that the Examiner withdraw the rejections of these claims, which are in condition for allowance.

4.   Claims 33 and 43

Claims 33 and 43 recite the claim limitation of a source IP address being validated by locating one or more delimiters in the Received line. On page 8 of the Office Action, the Examiner relies upon Figure 3, column 3, lines 39-41, and col. 4, lines 15-21 of Donaldson to reject these claims. However, these sections of Donaldson are directed to an unrelated process for connecting a sending Message Transfer Agent (MTA) to a receiving mail server for the transmission of email messages. This is entirely different from locating delimiters in the Received line to validate a source IP address, as recited in claims 33 and 43. Further, the Donaldson reference teaches away from the Examiner's interpretation of angle brackets by explicitly stating that the angled brackets shown in Fig. 3 "do not form a part of the message being transmitted" (see col. 4, lines 22-23). Thus, the angle brackets of Donaldson do not in any way teach or suggest the delimiters recited in claims 33 and 43. Therefore, Applicants

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respectfully request that the Examiner withdraw the rejections of claims 31 and 40, which are in condition for allowance.

5.   Claims 34 and 44

Claims 34 and 44 recite the claim limitation of categorizing a complaint. On page 8 of the Final Office Action, the Examiner relies upon column 7, lines 31-64 of Donaldson to reject these claims. However, this section of Donaldson merely recites seven categories of known solutions for blocking junk email messages and has nothing to do with categorizing a complaint. Therefore, the Final Office Action fails to establish a *prima facie* case of obviousness against claims 34 and 44, and Applicants respectfully request that the Examiner withdraw the rejections of these claims, which are in condition for allowance.

E.   Donaldson and Miloslavsky teach away from the combination suggested by the Examiner

In addition to the requirement that every claim limitation be taught or suggested by prior art references, a *prima facie* case of obviousness also requires: (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the reference teachings; and (2) a reasonable expectation of success. (MPEP 2143.) One of ordinary skill in the art, upon reading either Miloslavsky or Donaldson, would not have been motivated to look to the other reference to cure any deficiencies in the first reference because Miloslavsky and Donaldson are directed to solving different problems. On one hand, Miloslavsky is directed to the routing of emails to qualified customer support agents in a call center. In contrast, Donaldson is directed to filtering/blocking junk email by rejecting email received from unknown hosts. The routing and the blocking of emails are two different problems.

The Examiner states on page 3 of the Final Office Action that "there is no requirement that a motivation to make the modification be expressly articulated." In response to this statement, Applicants point to M.P.E.P. §2143.01, which, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed Cir. 1992), states:

> Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

If the Examiner intends to rely upon knowledge generally available to one of ordinary skill in the art as the motivation for combining Miloslavsky and Donaldson, Applicants respectfully

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request that the Examiner provide what knowledge is being relied upon, as well as support for the knowledge.

Inasmuch as the Examiner is relying on the references themselves as providing motivation for their combination, Applicants respectfully disagree with this conclusion. As stated on page 3 of the Final Office Action, "[t]he test for combining references is what the combination taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin, 170 USPO 209 (CCPA 1971)*." Further, a reference must be considered for all it teaches, including disclosures that teach away from the invention as well as disclosures that point toward the invention. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985). As discussed above, Donaldson and Miloslavsky teach away from their combination because of their contrasting purposes - the routing of emails versus the blocking of emails. Therefore, Applicants respectfully maintain that one of ordinary skill in the art would not have been motivated to combine Miloslavsky and Donaldson as asserted in the Final Office Action. For this additional reason, the Final Office Action fails to establish a *prima facie* case of obviousness against claims 28-34, 38-44, 49, and 50, and Applicants respectfully request that the Examiner withdraw the rejections of these claims.
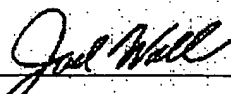
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CONCLUSION

All rejections have been addressed. In view of the above, the presently pending claims are believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 07-2347. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

Respectfully submitted,

Dated: February 8, 2005   By _____

Joel Wall
Attorney for Applicant
Reg. No.: 25,648
Verizon Corporate Services Group Inc.
c/o Christian Andersen
600 Hidden Ridge Drive,
Mailcode HQE03H14
Irving, TX 75038
(972) 718-4800
CUSTOMER NO.: 32127

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